

REMARKS

Applicants appreciate the Final Office Action of June 21, 2004. Applicants have amended Claim 21 as it should have been amended in the previous action. Applicants respectfully request entry of the amendment to Claims 21 to narrow the issues for appeal by removing the 112 rejections. Applicants submit that there is support in the specification for dependent Claims 9, 19, 29, 37, 38, 40, 41, 43 and 44 and, therefore, that these claims are in compliance with 35 U.S.C. § 112, first paragraph. Applicants submit that the drawings are in compliance with 37 C.F.R. § 1.83(a) for at least the reasons discussed below. Applicants respectfully submit that the pending claims are patentable over the cited references for at least the reasons discussed below and in Applicants' Amendment of March 15, 2004. Accordingly, the pending claims are in condition for allowance, which is respectfully requested in due course.

The Section 112 Rejections

Claim 21 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Final Office Action states:

Specifically, there is no support in the original disclosure of the teachings of a plurality of requested client properties being less than all available client properties found in the original discloser [sic] of the specification. Therefore, new subject matter will not be entered and the previous rejection still stands as restated below.

See Final Office Action, page 3, paragraph 4. Applicants have removed the recitation objected to in the Final Office Action from Claim 21. Applicants apologize as this recitation should have been removed from Claim 21, as it was removed from Claims 1 and 11 in Applicants' Amendment of March 15, 2004. Accordingly, Applicants submit that the 112 rejection with respect to Claim 21 has been obviated.

Claims 37, 40 and 43 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Final Office Action states:

Specifically, there is no support in the original disclosure of the teachings of a plurality of requested client properties included in the list in the link element are less than all client properties that may be included in the list found in the original discloser

[sic] of the specification. Therefore, new subject matter will not be entered and the previous rejection still stands as restated below.

See Final Office Action, page 3, paragraph 7. Applicants respectfully submit that no new matter is being added to the present application by the recitations of these claims for at least the reasons discussed below.

As stated in the summary of the present invention:

An object of the present invention is to provide, within a networked environment, a method by which a Web server **can indicate which device, user, software, and network properties can it use when generating personalized content for the requesting user.**

Another object of the present invention is to provide a method by which a Web server **can indicate which device, user, software, and network properties are required for it to generate any meaningful content for the requesting user...**

See Summary of the Invention, page 4, line 10 to page 5, line 11. In other words, embodiments of the present invention provide methods, systems and computer program products that allow a Web server to indicate "which properties" are used and/or required by the Web server to generate a customized output for the user. *There would be no need for a Web Server to indicate which properties it can use to generate personalized content, if all of the available properties were used.* It is apparent from the Summary of the Invention that the web server determines which properties it needs because less than all the properties are requested from the client.

Furthermore, methods of indicating properties that may be used by the server are discussed throughout the specification. For example, with respect to Figure 4B, the specification states:

The server may need to indicate to the client browser that the server that provides a particular linked document is capable of customizing the content or format of that document according to the client as long as the document request includes information about the hardware device, platform or application software, or user preferences. To do this, the server may include an additional attribute (PROFILEATTRS) with the link element **listing the properties that the referenced server can use to customize the referenced document.**

See specification, page 12, lines 15-20. *Again, there would be no need for a Web Server to indicate which properties it can use to customize the referenced document, if all of the*

available properties were indicated.

Responsive to Applicants arguments set out above, the Final Office Action states that "the cited areas of the Applicant's application indicate that it could use all the network properties that are given to the Web server." See Final Office Action, page 17, paragraph 65. Applicants submit that nothing prohibits Applicants from claiming certain aspects disclosed in the specification and not claiming other aspects. Accordingly, Applicants respectfully submit that the subject matter of dependent Claims 37, 40 and 43 is not new matter for at least the reasons discussed above and are in compliance with 35 U.S.C. § 112.

Furthermore, Claims 38, 41 and 44 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Final Office Action states:

Specifically, there is no support in the original disclosure of the teachings of a [sic] inserted at least one of said plurality of client properties is less than all the plurality of requested properties included in the link element is found in the original discloser [sic] of the specification. Therefore, new subject matter will not be entered and the previous rejection still stands as restated below.

See Final Office Action, page 4, paragraph 8. Applicants submit that no new matter has been added to the application by the recitations of these claims for at least the reasons discussed below.

Applicants direct the Examiner's attention to the background of the invention, which states:

Therefore, a need exists for a method and system that allows Web servers to indicate which device, user, software, and network properties can it use to generate personalized content for the requesting user. The Web server also needs to indicate which properties are actually required for it to generate any meaningful content at all. Using this mechanism, the client can optionally query the user for permission before including the requested information in the request. **Using the mechanism, the client furthermore can save bandwidth by only transmitting information that the server will use.**

See Background of the Invention, page 4, lines 1-8. The Summary of the Invention further recites:

Yet another object of the present invention is to provide a method **for reducing the amount of network bandwidth** consumed to transmit device, user,

software, and network information that is not used by the Web server.

See Summary of the Invention, page 5, lines 2-4. Thus, the client can conserve bandwidth by inserting less than all the requested client properties or by inserting only the information that the server will use. Accordingly, Applicants respectfully submit that the subject matter of dependent Claims 38, 41 and 44 is not new matter and that Claims 38, 41 and 44 are in compliance with 35 U.S.C. § 112 for at least the reasons discussed above.

Claims 9, 19 and 29 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Final Office Action states:

The limitation of, "transmitting the request without at least one of the selected ones of the plurality of request [sic] client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent", is not specifically found in the specification. The applicant is suggested to add the missing step that states that the client properties are not mandatory. This would narrow the scope of the claim and would require further search and consideration but would overcome the rejection stated above.

See Final Office Action, page 5, paragraph 11. Applicants appreciate the Examiner's suggestion with respect to the amendment of Claims 9, 19 and 29. However, Applicants have not amended Claims 9, 19 and 29, as Applicants submit that the disclosure clearly discusses the recitations as claimed. In particular, as indicated in the flowchart of Figure 5 and the corresponding text, if a property is mandatory, "the request cannot be successfully transmitted" without the mandatory property. See Specification, page 15, lines 19-23. Thus, if, as recited in Claims 9, 19 and 29, the request is transmitted without a requested client property, the property is by definition not mandatory. Thus, Claims 9, 19 and 29 do not have to be amended and Applicants submit that these claims are in compliance with section 35 U.S.C. § 112.

The Drawings are in compliance with 37 C.F.R. 1.83(a)

The drawings stand rejected under 37 C.F.R. 1.83(a) as failing to show every feature of the invention specified in the claims. In particular, the Final Office Action states that "the plurality of requested client properties being less than all available client properties must be shown or the features canceled from the claims." See Final Office Action, page 3, paragraph

5. Applicants respectfully submit that this feature is clearly illustrated in the Figures.

For example, Figure 5A illustrates the PROFILEATTRS, which designates a list of client properties that may be provided to the server from which the document is requested. As illustrated therein and described in the corresponding text, the PROFILEATTRS of Figure 5A only includes one client property, HardwareCharacteristics 346. As stated in the specification, "[t]he list 345 includes only one property...Additional properties may be included in the list 345 by separating them with a semi-colon." *See* Specification, page 13, lines 9-12. Thus, implying that there is more than one available client property. Thus, Figure 5A clearly illustrates the requested client properties being less than all available client properties as recited in dependent Claims 37, 40 and 43. *See* Figure 5A and the specification, page 13, lines 6-12.

Accordingly, Applicants respectfully submit that the drawings are in compliance with 37 C.F.R. 1.83(a) for at least the reasons discussed above. Applicants respectfully request reconsideration and withdrawal of the objections with respect to the drawings.

The Section 102 Rejections

Claims 1, 2, 11, 12, 21 and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 5,948,061 to Merriman *et al.* (hereinafter "Merriman"). As Claims 1, 11 and 21 are rejected over the same art as in the previous Office Action, Applicants submit that these claims are patentable for at least the reasons stated in Applicants' Amendment of March 15, 2004, the contents of which is hereby incorporated herein by reference in its entirety.

Responsive to Applicants' arguments the Examiner directs Applicants attention to the following portion of Merriman:

Also, if the domain for the new user has not previously been processed in the domain profile process, it may not be possible to target the advertisement for the new user and rather the new user should be shown a generic advertisement. Also, for new users, a promotional advertisement may be shown to get the new user to provide information about him or herself and his or her employer.

See Merriman, column 5, lines 43-49. With respect to the cited portion of Merriman, the

Final Office Action states:

Once the user selects an advertisement, (a link element), information about the user is gathered **because of the type of advertisement** that is presented and from other advertisements gathered by the system. **This can be interpreted in to the broad limitations of claims 1, 11 and 21.**

See Final Office Action, page 15, paragraph 60 (emphasis added). Applicants respectfully disagree. The cited portion of Merriman discusses providing generic advertisements to the new users and possibly learning information about the user using promotional advertisements. Nothing in the cited portion of Merriman discusses that the link element (advertisement) includes a plurality of requested client properties or that at least one of the plurality of requested client properties is inserted into the request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties as recited in Claim 1.

Furthermore, under 35 U.S.C. § 102, "a claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)(emphasis added)). Stated another way, all material elements of a claim must be found in one prior art source. See *In re Marshall*, 198 U.S.P.Q. 344 (C.C.P.A 1978). "Anticipation under 35 U.S.C. § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention." *Apple Computer Inc. v. Articulate Sys. Inc.*, 57 U.S.P.Q.2d 1057, 1061 (Fed. Cir. 2000). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" M.P.E.P. § 2112 (citations omitted).

A finding of anticipation further requires that there must be **no difference** between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill

in the art. *See Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). In particular, the Court of Appeals for the Federal Circuit held that a finding of anticipation requires **absolute identity** for each and every element set forth in the claimed invention. *See Trintec Indus. Inc. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002)(emphasis added). Additionally, the cited prior art reference must be enabling, thereby placing the allegedly disclosed matter in the possession of the public. *In re Brown*, 329 F.2d 1006, 1011, 141 U.S.P.Q. 245, 249 (C.C.P.A. 1964). Thus, the prior art reference must adequately describe the claimed invention so that a person of ordinary skill in the art could make and use the invention.

Thus, according to the case law set out above, **each and every element** as set forth in the claim must be found in the cited reference. This burden is not met by stating that a cited portion of the reference "can be interpreted in to the broad limitations of claims" as stated in the Final Office Action. *See* Final Office Action, page 15, paragraph 60. Furthermore, the case law further states that there must be **no difference** between the claimed invention and the disclosure of the cited reference. As discussed in Applicants' response of March 15, 2004, there are many differences between Merriman and Independent Claims 1, 11 and 21.

Accordingly, Applicants respectfully submit that Independent Claims 1, 11 and 21 are not anticipated by the cited reference for at least the reasons discussed above and in Applicants' Amendment of March 15, 2004. Thus, Independent Claims 1, 11 and 21 are patentable over the cited reference. Furthermore, dependent Claims 2, 12 and 22 are patentable at least per the patentability of Independent base Claims 1, 11 and 21 from which they depend. Accordingly, Applicants submit that Independent Claims 1, 11 and 21 and the claims that depend therefrom are in condition for allowance, which is respectfully requested in due course.

103 Rejections

Claims 6, 7, 16, 17, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being

unpatentable over Merriman in view of United States Patent No. 6,098,081 to Heidorn *et al.* (Hereinafter "Heidorn"). In Applicants' Amendment of March 15, 2004, the recitations of Claims 1, 11 and 21 were incorporated into Claims 6, 16 and 26, respectively. Thus, Claims 6, 16 and 26 are patentable for at least the reasons discussed above and in Applicants' previous Amendment of March 15, 2004 with respect to Claims 1, 11 and 21. Accordingly, Claims 6, 16 and 26 are independently patentable over the cited references for at least these reasons. Furthermore, Claims 7, 17 and 27 are patentable at least per the patentability of independent Claims 1, 11 and 21 from which they depend.

The Dependent Claims are Patentable at least per the Patentability of the Base Claims

Claims 5, 15, 25, 32, 34 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of United States Patent No. 6,401,085 to Gershman (hereinafter "Gershman"). Claims 7, 17 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of Heidorn. Claims 8, 18 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of Heidorn in further view of Gershman. Claims 9, 19, 29, 39, 42 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of Heidorn in further view of Gershman in further view of United States Patent Application No. 6,268,856 to Bruck *et al.* (hereinafter "Bruck"). Claims 10, 20 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of Heidorn in further view of Bruck. Claims 37, 38, 40, 41, 43 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of Gershman. Applicants respectfully submit that the dependent claims are patentable at least per the patentability of independent base Claims 1, 11 and 21 from which they depend.

Many of the Dependent Claims are Independently Patentable

As discussed above, the dependent claims are patentable over the cited references at least per the patentability of the independent base claims from which they depend. Many of the dependent Claims are also independently patentable.

For example, Claim 7 recites, in part:

wherein said step of inserting comprises the steps of:
selecting ones of the plurality of requested client properties included in the
link element; and
determining whether selected ones of the plurality of requested client
properties are available to be transmitted.

Claims 17 and 27 contain corresponding system and program product recitations. As discussed above with respect to Claims 1, 11 and 21, nothing in the cited references discloses or suggests a link element including a plurality of requested client properties or inserting at least one of the requested client properties into a request as recited in Claim 7. Thus, it follows that nothing in the cited references discloses or suggests details with respect to inserting the at least one of the requested client properties into the request. Accordingly, Claims 7, 17 and 27 are separately patentable over the cited references for at least these additional reasons.

By way of further example, Claim 9 recites:

The method of Claim 7 further comprising:
prompting a user whether to transmit the selected ones of the plurality of
requested client properties if it is determined that at least one of the plurality of
requested client properties is available to be transmitted; and
transmitting the request without at least one of the selected ones of the
plurality of requested client properties if the user indicates the selected ones of the
plurality of requested client properties are not to be sent.

Claims 19 and 29 contain corresponding system and computer program product recitations. As stated above, Claims 9, 19 and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman in view of Heidorn in further view of Bruck. The Final Office Action admits that Merriman does not specifically teach that the step of prompting a user whether to transmit the selected ones of the plurality of requested client properties as recited in Claim 9. *See* Final Office Action, page 11, paragraph 45. The Final Office Action further admits that Heidorn does not fully provide the missing teachings. *See* Final Office Action, page 12, paragraph 47. However, the Final Office Action points to the combination of Heidorn and Bruck to provide the missing teachings. *See id.* Applicants respectfully disagree.

Bruck discusses methods and systems "for suppressing or otherwise controlling the display of unrequested content" as stated in the abstract, not customization of a requested document as recited in the claims of the present invention. *See* Bruck, Abstract. The cited portions of Bruck discuss, for example, suppressing advertisements directed to a competitor's product or suppressing advertisements when important data is being viewed. *See* Bruck, column 10, lines 51-67 and column 13, lines 29-48. Nothing in the cited portion of Bruck discusses prompting a user for permission to transmit information as recited in Claims 9, 19 and 29. Gershman discusses a system for displaying and retrieving information from the web using a handheld device. *See* Gershman, column 3, lines 14-29. The cited portion of Gershman discusses prompting the user to input information of interest to the user, but does not prompt the user for permission to transmit information requested in a link as recited in Claims 9, 19 and 29. *See id.* Thus, the cited portions of Bruck and Gershman do not disclose or suggest "prompting a user whether to transmit the selected ones of the plurality of requested client properties" as recited in Amended Claims 9, 19 and 29. Furthermore, nothing in the cited references discloses or suggests "transmitting the request without at least one of the selected ones of the plurality of requested client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent" as further recited in Claims 9, 19 and 29. Accordingly, Claims 9, 19 and 29 are separately patentable over the cited references for at least these additional reasons.

Claim 10 recites "terminating the request if it is determined that at least one of the selected ones of the plurality of requested client properties is not available to be transmitted and the at least one of the selected ones of the plurality of requested client properties that is not available to be transmitted is a mandatory property." Claims 20 and 30 contain corresponding system and program product recitations. As stated above, Claims 10, 20 and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman in view of Heidorn in further view of Bruck. Applicants respectfully disagree. Nothing in the cited references discloses or suggests that at least one of the plurality of client properties is designated as a mandatory property, thus, it also follows that none of the cited references discloses or suggests terminating the request based on the mandatory property not being

available to be transmitted as recited in Claims 10, 20 and 30.

The Final Office Action states:

Furthermore, if the user didn't have the information that is mandatory for the system to function then the system would not be able to execute its functions therefore, making the inventions functions useless.

See Final Office Action, page 13, paragraph 53. Applicants respectfully submit that the designation of a property as "mandatory" only becomes necessary if "less than all of the available properties" are being provided according to embodiments of the present invention. The cited references do not disclose systems where this is the case, thus, the user of the systems discussed in the cited references does not need information about mandatory properties to function, as all the available properties are provided. Accordingly, Claims 10, 20 and 30 are separately patentable over the cited references for at least these additional reasons.

Dependent Claim 37 recites:

The method of Claim 1, wherein the plurality of requested client properties included in a list in the link element are less than all client properties that may be included in the list.

Claims 40 and 43 contain corresponding system and program product recitations. As stated above, Claims 37, 40 and 43 stand rejected over Merriman in view of Gershman. The Final Office Action admits that Merriman does not specifically teach the recitations of Claim 37, but states that Gershman provides the missing teachings. See Final Office Action, page 14, paragraph 56. The cite portion of Gershman recites, in part:

The first attempts to dynamically deal with information overload were primarily focused on the intelligent filtering of information such that the quantity of information would be lessened. Rather than simply removing random bits of information, however, most of these approaches tried to be intelligent about what information was ultimately presented to the user. This was accomplished by evaluating each document based on the user's interests and discarding the less relevant ones. It follows, therefore, that the quality was also increased.

See Gershman, column 46, lines 51-60. As stated therein, the cited portion of Gershman discusses discarding "less relevant" information. Nothing in the cited portion of Gershman discloses or suggests including *in a list in the link element, less than all client properties* as

recited in Claim 37. Accordingly, Claims 37, 40 and 43 are separately patentable over the cited references for at least these additional reasons.

Dependent Claim 38 recites:

The method of Claim 1, wherein the inserted at least one of said plurality of client properties is less than all the plurality of requested properties included in the link element.

Claims 41 and 44 contain corresponding system and program product recitations. As stated above, Claims 38, 41 and 44 stand rejected over Merriman in view of Gershman. The Final Office Action does not even address the specific recitations of these claims. Applicants submit that nothing in the cited combination discloses or suggests the recitations of Claim 38. Accordingly, Claims 38, 41 and 44 are separately patentable over the cited references for at least these additional reasons.

Accordingly, as stated in Applicants' response of March 15, 2004, none of the cited references either alone or in combination disclose or suggest the recitations of at least the dependent claims set out above. Furthermore, there is no motivation to combine the cited references as suggested in the Final Office Action. To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. The mere fact that references **can be combined or modified** does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). There is no motivation or suggestion to modify the cited reference as suggested in the Final Office Action. As recently affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. See *In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its

teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

Responsive to Applicants' arguments in their Amendment of March 15, 2004, the Final Office Action cites *In re MacLaughlin*, which is a Court of Customs and Patent Appeals case from 1971. More recent case law of the Court of Appeals for the Federal Circuit makes clear that this does not imply that sweeping, conclusory inferences drawn from multiple references meet the requirements for support of a rejection under § 103. In particular, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be *clear and particular*, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *See, e.g., In re Dembiczak*, 50 U.S.P.Q.2d 1614; 1617 (Fed. Cir. 1999). The Final Office Action does not point to any portion of the cited references as providing a motivation to combine the references. Each of the cited references include different uses of links, networks, and the like, and a § 103 rejection may not be supported simply by throwing these disparate arrangements of teachings together in an *ad hoc* fashion, as these proposed changes would fundamentally change the functionalities of the inventions described in the cited references. A person of skill in the art would not be motivated to combine these references without using Applicants' disclosure as a road map. Thus, it appears that the Final Office Action gains its impetus or suggestion to modify the cited reference by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references. Finally, even if combined the cited combination does not disclose or suggest the recitations of the pending claims for at least the reasons discussed above.

For at least the foregoing reasons, Applicants respectfully submit that at least the dependent claims discussed above are independently patentable over the cited references. Accordingly, Applicants submit that the dependent claims are in condition for allowance, which is respectfully requested in due course.

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CONCLUSION

Applicants respectfully submit that pending claims are in condition for allowance, which is respectfully requested in due course. Favorable examination and allowance of the present application is respectfully requested. It is not believed that any extension of time is required for this paper. However, in the event that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to our Deposit Account No. 09-0461.

Respectfully submitted,



Elizabeth A. Stanek
Registration No. 48,568

USPTO Customer No. 46589
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401